

ATTORNEY DOCKET NO. 076397-0124

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Applicant: Klaus BUECHER et al.

Title: MEMBRANE ELEMENT AND PROCESS FOR
ITS PRODUCTION

Appl. No.: 09/329,258

Filing Date: June 10, 1999

Examiner: A. Fortuna

Art Unit: 1723

**REQUEST FOR WITHDRAWAL OF FINAL OFFICE ACTION AND
PRELIMINARY REMARKS**

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants request that the Office Action mailed on March 13, 2002 be withdrawn in its entirety, and request consideration of the following remarks prior to examination.

REMARKS

Applicants acknowledge receipt of an Office Action dated March 13, 2002.

REQUEST TO WITHDRAW OFFICE ACTION

The Continued Prosecution Application Request Transmittal, filed on February 27, 2002, did not contain an authorization to charge a deposit account and the box was checked on the transmittal next to the statement "[t]he required filing fees are not enclosed but will be submitted in response to the Notice to File Missing Parts of Application." Apparently, the PTO has charged Applicant's Representative's deposit account for the required filing fees even though the paper contained no authorization to do so. As noted on the Continued

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Prosecution Request Application Transmittal, the petition for extension of time was submitted in a *separate* paper. *Accordingly, Applicants respectfully request that the PTO withdrawal of the Final Office Action dated March 13, 2002 ("Final Office Action").*

Outstanding Rejection

In addition, with the exception of the addition of headings, the March 13th Office Action appears to be a verbatim recitation of the rejections set forth in the Office Action dated February 14, 2001 (hereafter "2/14/01 OA"). Thus, the Final Office Action fails to address the amendments and remarks presented in Applicants' response filed June 14, 2001. For example, the Final Office Action fails to address claims 15-26 which were presented for the first time in the paper filed June 14, 2001.

Applicants further note that the PTO issued an Office Action on August 28, 2001 (hereafter "8/28/01 OA"), subsequent to the 2/14/01 OA. In the 8/28/01 OA, the PTO withdrew the rejection of claims 1, 2 and 3 under 35 U.S.C. §102(b) based upon U.S. Patent 5,147,541 to McDermott, Jr. *et al* (hereafter "McDermott") as well as the rejection of claims 4-6 under 35 U.S.C. §103(a) as unpatentable over McDermott and U.S. Patent 5,073,263 to Fagundes *et al.* and further in view of U.S. Patent 5,082,472 to Mallouk *et al.* The 8/28/01 Office Action set forth a new rejection of claims 1-6 and new claims 15-26 under 35 U.S.C. §103(a) based upon U.S. Patent 5,562,827 to Schmidt, *et al.* (hereafter "Schmidt") in view of McDermott.

Thus, it is Applicants understanding that the earlier rejections have already been overcome. Applicants further provide the following remarks concerning the 8/28/01 Office Action.

Rejections Under 35 U.S.C. §103(a)

In the 8/28/01 OA, the PTO has rejected claims 1-6 and 15-26 under section 103 as being unpatentable over Schmidt in view of McDermott. Applicants respectfully traverse this rejection.

Schmidt fails to teach or fairly suggest (1) a sheath comprising a polymer film, (2) at least a partial overlap of the polymer film or (3) fusion in the area of overlap as recited in independent claims 1, 21 and 26.

Applicants note that independent claim 1 recites “a sheath [that]...comprises polymer films...which, at least partially, overlap one another and have been fused to one another in the area of overlap.” Claim 21 recites “a sheath...formed from said polymer film wound spirally around said membrane element and said core such that said polymer film partially overlaps itself and such that said polymer film is fused together in the region of said overlap.” Claim 26 recites, “a sheath [that] comprises polymer films...which, at least partially overlap one another and have been fused to one another in the area of overlap.”

Applicants note that the membrane/core assembly of Schmidt is surrounded by “a cord, fabric or laminated material” (see col. 2, lines 44-47). Although the detailed description provides further discussion of the cord (see e.g. drawings in Schmidt et al.), it remains unclear what a “laminated material” might be. There is no further explanation of “laminated material” in Schmidt such that it would be unclear to one skilled in the art what a “laminated material” encompasses. Schmidt does not clearly disclose a comprising polymer film(s), partial overlap of the polymer film(s), or fusion of the overlap of the polymer film(s)

McDermott fails to resolve this deficiency in Schmidt. Specifically, McDermott nowhere teaches or fairly suggests (1) a sheath comprising or formed from a polymer film, (2) a partial overlap of the polymer film or (3) fusion in the area of overlap as in independent claims 1, 21 and 26.

McDermott is not concerned with stabilizing a membrane assembly but with the design and setup of the membrane itself. Therefore, when McDermott mentions “fusing”, it is the fusing of a pleated and reinforced membrane near the core, and not the fusing of anything that surrounds the wound membrane assembly such as the recited sheath in the present invention (see the drawings in McDermott et al.; specifically Fig. 2). Thus the Examiner’s reference to “fusing the membrane” in the 8/28/01 Office Action is not understood. The claimed invention is directed to fusing the polymer film sheath that surrounds the membrane, not fusing of the membrane itself.

McDermott is not concerned about the stability of the wound membrane let alone about any problems with respect to the stability of the membrane assembly.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claims 1-6 and 15-21 under §103(a). Therefore McDermott does not provide any motivation to the person of ordinary skill in the art concerning improving the outer sheath around the membrane. The combination of Schmidt and McDermott does not lead to the present invention, and cannot render it unpatentable.

CONCLUSION

In view of the foregoing, applicants respectfully submit that all of the pending claims are in condition for allowance. An early notice to this effect is earnestly solicited.

If, following consideration of the foregoing, the Examiner does not find the application to be in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned to schedule an interview.

Respectfully submitted,

Date March 29, 2002

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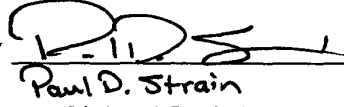
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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.